

REMARKS

Reconsideration of this application in light of the present amendment and remarks is respectfully requested.

RESPONSE TO RESTRICTION REQUIREMENT: The above-identified application is subject to a restriction requirement as between:

Group I: Claims 1, 2, 5-8, 11-12, 13, 15-17, 19 and 22, drawn to determining whether an advertisement has been delivered; and terminating advertisements upon reaching a quota, classified in Class 705, subclass 14; and

Group II: Claim 27, drawn to a method for providing advertisements based upon the status of sensors in a vehicle, classified in Class 701, subclass 1,

on the grounds that Inventions I and II are related as subcombinations usable together in a single combination, and are distinct if it they are shown to be separate usable.

Applicants herewith non-provisionally elect to prosecute the Group 1 claims (1, 2, 5-8, 11-12, 13, 15-17, 19 and 22), without traverse.

Claim 27 is drawn to a non-elected invention and has been withdrawn.

AMENDMENT

Claims 1-2, 5-8, 11-13, 15-17, 19 and 22 have been rejected.

Claims 3, 4, 9, 10, 14, 18, 20, 21 and 23-26 were previously canceled.

Claim 27 has been withdrawn.

No claims have been amended.

Claims 1-2, 5-8, 11-13, 15-17, 19, 22 are pending in this application.

Claims 1-2, 5-8, 11-13, 15-17, 19 and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg et al. (U.S. Patent No. 6,183,366 hereinafter Goldberg) in view of Hall et al. (U.S. Patent No. 6,026,375 hereinafter Hall). This rejection is respectfully traversed.

Regarding independent claims 1 and 13, applicants respectfully disagree with the Examiner's statement that the termination of advertisements is obvious, inasmuch the Examiner

has shown no evidence of any case where advertisements are terminated while the information or entertainment service access continues advertisement free. Moreover, claims 1 and 13 recite a specific technique to provide this previously unknown service, using quotas. The Examiner previously admitted that neither Goldberg nor Hall disclose the provision for a quota within a predetermined time period and terminating advertisements upon reaching the quota. Since no prior art has been shown to terminate advertisements while continuing service, applicants submit that is completely non-obvious to use a quota system to terminate advertisements while continuing service.

In regards to the Examiner's statement regarding applicants' misunderstanding of quotas, applicants did not mean to state that Internet access is subject to quotas. Instead, applicants wish to point out that Goldberg recites that Internet access is free while advertisements are repeatedly downloaded (col. 29, lines 15-20), without condition. Therefore, the implication is that if advertisements could not be repeatedly downloaded then internet access would not be free. As a result, the effect is that free internet access is subject to continually receiving advertisements. In addition, if Goldberg had envisioned the cessation of advertisements upon reaching a quota then Goldberg would not refer to the *repeated* downloading of advertisement. Since Goldberg did not qualify this statement, it must be taken as one normally skilled in the art would interpret it, i.e. advertisements never end, as is the commonly recognized normal business practice, which teaches away from applicants' invention.

Therefore, applicants wish to reiterate that there are presently no known provisions in such cases for the termination of advertisements while continuing service access, and further that that there is no mention of quotas for the termination of advertisements while continuing service access. Applicants respectfully submit that these two steps are essential in the understanding of applicants' invention, and neither are present in the cited art. Further, since the use of advertisement quotas are unknown in the art it would not be obvious to use advertisement quotas for the termination of advertisements while continuing service access. Even one skilled in the art could not make these two leaps, and in fact has not made these leaps.

Therefore, applicants must restate that to establish *prima facie* obviousness of a claimed invention, at least these two limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA

1970). In this case, for the reasons stated above, all the claim limitations are not taught or suggested by the prior art. Thus, the cited references clearly fail to render obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the applicants' specification, it is a substantial benefit to use the claimed invention because it uses a quota to permit a user relief from relentless presentation of advertisements. The known art, for the reasons mentioned above, simply does not suggest the desirability of the claimed invention since it doesn't provide for the termination of advertisements while continuing Internet access.

Deficiencies of the cited references cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art), and in particular where the known art teaches away from applicants' invention as explained above.

Applicants' invention provides a business case that is unknown in the art wherein a Internet service provider would provide an advantage for a user to use that particular access provider by the knowledge that advertisements will stop after reaching a quota whereinafter the user would have uninterrupted Internet access. In this way, the use of quotas would be much more likely to lure users to a service, in that, a user would be much likely to subscribe to a service if they knew they would not be subject to an endless barrage of advertising, but instead be subject to a fair portion of advertising in exchange for their patronage.

Claims 2 and 12 are dependent on claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above.

Further, in regard to claim 12, none of the office actions address the step of providing advertisements based upon the status of sensors in a vehicle incorporating the wireless communication device. This can be very valuable to determine whether and when a user actually views an advertisement. None of the cited references or known art discuss, or make any mention of, vehicle sensors much less advertisements based upon such vehicle sensors. The applicant respectfully requests for identification of where this feature is located in the cited references.

Regarding independent claim 13, the above comments with respect to claim 1 also apply to claim 13. In addition, the cited art teaches a system to check whether advertisements are presented in a destination device, but does not provide a definitive technique to guarantee that a user actually observes the advertisement from the destination device. For example, a user may be outside their car while an advertisement is playing, and therefore does not observe the advertisement. Applicants solve this problem by requiring a manual interaction where the user actually acknowledges the receipt of the advertisement. The inclusion of manual feedback is a significant difference from the cited art. Therefore, applicants' invention of claim 13 solves a problem that is not address by the cited art.

Again, the Examiner goes on to state that a provision to have a user acknowledge an advertisement would be obvious to one skilled in the art. However, to establish *prima facie* obviousness of a claimed invention, the practice of a user manually acknowledging advertisements must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). In this case, for the reasons stated above, there is no art cited that has a user manually acknowledge the receipt of advertisements. Therefore, all the claim limitations are not taught or suggested by the prior art. Thus, the cited references clearly fail to render obvious the claims.

Moreover, a proposed modification or combination of prior art cannot be made if the prior art does not suggest the desirability of the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As mentioned above and in the applicants' specification, there is a benefit to a service provider to supply definitive evidence that an advertisement has been actually viewed by have a viewer manually acknowledge same. The known art, for the reasons mentioned above, simply does not suggest the desirability of providing manual interaction, but instead providing a convoluted automatic process between devices that only proves the advertisement was presented by a device, but does not guarantee that the advertisement was reviewed by an actual person. The prior art only describes a user that interacts with an advertisement of interest to gain more information. This is not done for the purposes of acknowledgement that the user has received the advertisement, but is only incidental thereto, and therefore teaches away from applicants' invention.

Deficiencies of the cited references cannot be remedied by the conclusions about what is well known or what one skilled in the art could have done. *In re Zurko*, 258 F.3d 1379, 1385-1386 (Fed. Cir. 2001) (Assessment of basic knowledge and common sense in the art must be based on evidence in the record and cannot be based on unsupported assessment of the prior art), and in particular where the known art teaches away from applicants' invention as explained above.

Claims 5, 6 and 11 are dependent on claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above.

Claim 17, 19 and 22 are dependent on claim 13, and therefore include all of the recitations of claim 13, which are not disclosed or suggested by the references, as described above.

Accordingly, it is respectfully submitted that this rejection has been overcome.

Claims 7, 8, 15 and 17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Goldberg in view of Hall as applied to claims 1, 2, 5, 6, 11-13, 17, 19, 22 and 27 above, and further in view of Titmuss et al. (WO 98/47295 hereinafter Titmuss). This rejection is respectfully traversed.

Claims 7 and 8 are dependent on claim 1, and therefore include all of the recitations of claim 1, which are not disclosed or suggested by the references, as described above.

Claim 15 and 17 are dependent on claim 13, and therefore include all of the recitations of claim 13, which are not disclosed or suggested by the references, as described above.

Accordingly, it is respectfully submitted that this rejection has been overcome.

Applicants respectfully submit that the prior art references, in combination or alone, fail to teach or suggest all of applicants' claimed limitations, as required for a 35 USC §103(a) rejection. Namely, with regard to claims 1 and 13 (and their dependent claims), none of the references teach at least the steps of: providing a quota of advertising, determining whether advertisements actually have been viewed, terminating advertisements upon reaching a quota, or providing advertisements based upon the status of sensors in a vehicle. Further, with regard to claim 13, none of the references teaches at least the step of requiring user interaction to

determine whether an advertisement was reviewed. Applicants submit that these many limitations can not all be rendered obvious without any corroborating references.

Therefore, the teachings of the cited art, in combination or alone, fail to teach or even suggest the novel and unobvious recitations of the above claims. For the foregoing reasons, applicants believe that the claims, as amended, are patentably distinct and non-obvious from all of the references of record, whether taken alone or in combination.

Accordingly, it is respectfully submitted that this rejection has been overcome.

The other references of record have been reviewed and applicant's invention is deemed patentably distinct and nonobvious over each taken alone or in combination.

For the foregoing reasons, applicants respectfully request that the above rejections be withdrawn.

Inasmuch as this amendment distinguishes all of the applicants' claims over the prior art references, for the many reasons indicated above, passing of this case is now believed to be in order. A Notice of Allowance is earnestly solicited.

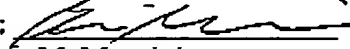
No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicants' attorney at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection or through an Examiner's amendment.

Authorization is hereby given to charge any fees necessitated by actions taken herein to Deposit Account 50-2117.

Respectfully submitted,
Steele et al.

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